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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,574	10/08/2003	Gary Roger Miller	58575-281077	6831
7590 11/19/2004				
FAEGRE & BENSON LLP		EXAMINER		
2200 Wells Fargo Center		LE, HOA VAN		
90 South Seventh Street				
Minneapolis, MN 55402-3901		ART UNIT		
		PAPER NUMBER		
		1752		

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,574

Applicant(s)

MILLER ET AL.

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-71 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

In view of the complexity of the claims as set up, this Office action is made.

A.1. Claims 1-71 are generic to a plurality of disclosed patentably distinct species comprising many possible organic solvents in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed organic solvent species for an initial search, even though this requirement is traversed.

2. Claims 1-71 are generic to a plurality of disclosed patentably distinct species comprising many possible strong base in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed strong base species for an initial search, even though this requirement is traversed.

3. Claims 1-71 are generic to a plurality of disclosed patentably distinct species comprising many possible weak base in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed weak base species for an initial search, even though this requirement is traversed.

4. Claims 1-71 are generic to a plurality of disclosed patentably distinct species comprising many possible dispersing agents in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed strong base species for an initial search, even though this requirement is traversed.

5. Claims 50-71 are generic to a plurality of disclosed patentably distinct species comprising many possible polymeric materials in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed polymeric species for an initial search, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

- B. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-36, drawn to an aqueous developer, classified in class 430, subclass 331.
 - II. Claim 37, drawn to a developer system or apparatus, classified in class 396, subclass 636.
 - III. Claims 38-49, drawn to a method for regenerating a used developer, classified in class 430, subclass 399.
 - IV. Groups of claims (50-65) and (66-67) (with independent claim 50 being broadest. They are not considered to be patentably different or distinct invention. Accordingly, no restriction is made. Therefore, no separate invention is considered or searches. Should applicants disagree, show or urge otherwise in the next response to this Office action in order for it to be considered timely, a restriction will be made for the record as disagreed, shown or urged in the response), drawn to a method for developing an exposed polymer layer containing plates, classified in class 430, subclass 300

- V. Claims 68-71, drawn to another method for developing an exposed polymer layer containing plates being patentably different and distinct step and material for using in the step, classified in class 430, subclass 327.
- VII. Claim 19, drawn to an image forming method using the silver halide color photographic material (of claim 17) containing the iridium sensitized emulsions of claims 10, classified in class 430, subclass 377. If claim 10 or 117 is elected for an examination and found to be allowable, claim 20 will be let to be rejoined.
- * All claims will be allowable if the broadest claim 1 is elected, considered, searched and found to be allowable.

The inventions of Groups I and are related to the materials but have the patentably different and distinct subject matter and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants. Restriction for examination as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

The inventions of Groups III, IV and V are all related to the methods but have the patentably different and distinct reactant materials and processing steps and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants. Restriction for examination as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Inventions Groups (I and II) and Groups (III, IV and V) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process, such as developing an exposed polymer layer containing plates without using an additional replenishing or regenerating step and its material as required in the instant claims as conventionally and well known and done in the art. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants. Restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

C. An additional consideration or search for more than one invention or subclass in the art is burdensome. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

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D. Applicant is advised that the reply to this requirement to be complete must include an election to be examined even though the requirement be traversed (37 CFR 1.143).

E. Other issues have not been considered until full and proper elections and requirements are made and resolved.

F. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le